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09/780,962	02/09/2001	Erik James Reed	85804-019800 (Y62-40406)	6926
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GREENBERG TRAURIG, LLP MET LIFE BUILDING 200 PARK AVENUE NEW YORK, NY 10166			SIDDIQI, MOHAMMAD A	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/780,962

Applicant(s)

REED, ERIK JAMES

Examiner

Mohammad A. Siddiqi

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 and 55-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 and 55-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-36 and 55-58 are presented for examination. Claims 37-54 have been cancelled. *Claims 55-58 are new.*

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: specification does not properly disclose subject matter such as: master table of content information and master songprint identifier, as claimed in claims 1, 23, 25 and 27.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1, 23, 25,27, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: How the table of content information is received at the network server".

5. Claims 1, 23, 25,27, and 29 recites the limitation "songprint identifier is derived from digitized content" in last line of the claims. There is insufficient antecedent basis for this limitation in the claim. Examiner cannot determine which songprint identifier is referred to, multiple songprint identifiers in specification or recited master songprint identifier in the claim.

6. Claims 1, 23, 25,27, and 29 recites the limitation "songprint identifier is derived from digitized content" in last line of the claims. There is insufficient antecedent basis for this limitation in the claim. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed... (In re Zletz 13 USPQ2d 1320 (Fed. Cir. 1989))

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim which claims both an apparatus and the method steps of

using the apparatus is indefinite, because it is unclear which category of invention is being claimed. (Ex Parte Lyell, 17 USPQ2d 1548 (BPAI 1990)).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-36 and 55-58 rejected under 35 U.S.C. 103(a) as being unpatentable over anticipated by Hurtado et al. (6,611,812) (hereinafter Hurtado) in view of Carpentier et al. (6,807,632) (hereinafter Carpentier).

10. As per claim 1, Hurtado discloses in a system comprising a communications network connecting a plurality of network servers and a plurality of computers, a network server comprising:

a verification database comprising (col 26, lines 45-65, and col 31, lines 55-64);

master table of contents (metadata provides information about the content, quality, condition, and other characteristics of data, here metadata provides information about the music CD .g., artist, producer, album cover, track length, col 12, lines 17-25) information corresponding to each of a plurality of sets of digitized content (col 20, lines 14-35 and col 72, lines 54-64);

at least one master songprint identifier corresponding to each of the plurality of sets of digitized content (metadata secure container, col 30, line 46 – col 32, line 67); and

wherein the network server is programmed to (figs 10-16, col 83, col 15, lines 15-44);

receive at least one of a plurality of songprint identifiers from the at least one of the plurality of computers (figs 10-16, col 83, col 15, lines 15-44), and

Hurtado further discloses in columns 16-17 "In the Secure Digital Content Electronic Distribution System 100, since SC(s) contain several data parts, a digest is calculated for each part and a summary digest is calculated for the concatenated part digests. The summary digest is encrypted using the private key of the issuer of the SC(s). The encrypted summary digest is the issuer's digital signature for the SC(s). The part digests and the digital signature are included in the body of the SC(s). The recipients of SC(s) can verify the integrity of the SC(s) and its parts by means of the received digital signature and part digests.

A one-way hash algorithm is used to calculate a message digest. A hash algorithm takes a variable-length-input message and converts it into a fixed length string, the message digest. A one-way hash algorithm operates only in one direction. That is, it is easy to calculate the digest for an input message, but it is very difficult (computationally infeasible) to

generate the input message from its digest. Because of the properties of the one-way hash functions, one can think of a message digest as a **fingerprint of the message**.

The more common one-way hash functions are MD5 from RSA Data Security and SHA designed by the US National Institute of Technology and Standards (NITS). "

Hurtado specifically does not disclose wherein each songprint identifier is derived from digitized content. Songprint identifier is derived from the digitized is commonly known knowledge in the distribution of digital asset such as music. For example, Carpentier discloses each songprint identifier is derived from digitized content (col 25, lines 28-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Hurtado and Carpentier. The motivation would have been to secure delivery and rights management of digital assets over global communication network.

11. As per claims 2 and 30, claims are rejected for the same reasons as claim 1, above. In addition, Hurtado discloses to receive one selection of table of content information from the at least one of the plurality of computers (figs 10-16, col 83, col 15, lines 15-44).

12. As per claims 3 and 31, claims are rejected for the same reasons as claim 1, above. In addition, Hurtado discloses to receive a songprint identifier from the at least one of the plurality of computers (figs 10-16, col

83, col 15, lines 15-44).

13. As per claim 4, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses wherein the table of content information comprises at least one length of digital content (fig 16, col 61, lines 25-29).

14. As per claim 5, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses to request at least one of a plurality of regions of digitized content from the at least one of the plurality of computers (fig 16, col 95-96).

15. As per claim 6, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses to request one region of digitized content from the at least one of the plurality of computers (col 95-96).

16. As per claim 7, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses the request for one or more regions of digitized content is generated as a function of a pseudo-random sequence (col 4, lines 26-67).



17. As per claim 8, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses the pseudo-random sequence is a function of a network address of the at least one of the plurality of computers (col 4, lines 26-67).

18. As per claim 9, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the pseudo-random sequence is a function of a time of day (fig 2, col 4, lines 26-67).

19. As per claim 10, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the pseudo-random sequence is a function of both a network address of at least one of the plurality of computers and a time of day (fig 1, col 4, lines 26-67).

20. As per claim 11, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses wherein the request for regions of digitized content is further comprised of a request for at least one of a plurality of decoy regions of digitized content from the at least one of the plurality of computers (user interface, col 88, lines 29-51).

21. As per claim 12, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the request for an at least one of a plurality of decoy regions of digitized content is a function of a pseudo-random sequence (see discussion, col 4, line 26- col 5 line 19).

22. As per claim 13, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the pseudo-random sequence is a function of a network address of the at least one of the plurality of computers (see discussion, col 4, line 26- col 5 line 19).

23. As per claim 14, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the pseudo-random sequence is comprising a function of a time of day (see discussion, col 4, line 26- col 5 line 19).

24. As per claim 15, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the pseudo-random sequence is comprising a function of both a network address of the at least one of the plurality of computers and the time of day (see discussion, col 4, line 26- col 5 line 19).

25. As per claim 16, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses wherein the request for one or more than regions of digitized content is further comprised of only one non-decoy region of digitized content from the at least one of the plurality of computers (see discussion, col 4, line 26- col 5 line 19).

26. As per claim 17, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses wherein the verification database is further comprised of only one master table of contents identifier for each of a corresponding plurality of sets of digitized content (digital content library, col 95, lines 8-29).

27. As per claim 18, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses wherein the verification database is further comprised of only one master songprint identifier for each of a corresponding plurality of sets of digitized content (col 12, lines 17-25 and col 31, lines 55-64)

28. As per claims 19 and 32, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses further programmed to verify whether the received table of content information correlates with the master

table of content information (col 31, lines 55-64).

29. As per claims 20, 24, 28 and 33, claims are rejected for the same reasons as claim 1, above. In addition, Hurtado discloses to verify whether the received table of content information correlates perfectly with the master table of content information (col 31, lines 55-64).

30. As per claims 21, the claim is rejected for the same reasons as claim 1, above. In addition, Hurtado discloses programmed to verify whether the received songprint identifiers correlates with the master songprint identifier (col 31, lines 55-64 and col 12, lines 17-25).

31. As per claims 22, 26, 34, and 35, claims are rejected for the same reasons as claim 1, above. In addition, Hurtado discloses further programmed to verify whether the received songprint identifier correlates perfectly with any master songprint identifier (col 31, lines 55-64 and col 12, lines 17-25).

32. As per Claim 23, 25, 27 and 29 are rejected based on the same reasoning as claim 1, in addition to Hurtado discloses as a function of whether or not the received selections of table of contents information

correlate with any of the master table of contents information (col 31, lines 55-64 and col 12, lines 17-25),

request at least one of a plurality of regions of digitized content from the at least one of plurality of computers (HTML pages, col 88, lines 33-51).

33. As per claim 36, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses further programmed to generate the master table of contents identifier by performing steps of: reading table of contents data from the medium (see discussion, col 4, line 26- col 5 line 19);

computing a cryptographic hash value of the concatenation of the lengths of each track on the medium (see discussion, col 4, line 26- col 5 line 19); and  
truncating the cryptographic hash value (see discussion, col 4, line 26- col 5 line 19).

55. As per claim 55, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses each master songprint identifier is derived from a digitized content master, and wherein each received songprint identifier is derived from a digitized content copy (see discussion, col 4, line 26- col 5 line 19).

56. As per claim 56, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses the server receives table of contents Information and a songprint identifier corresponding to the digitized content copy, and wherein the server is further programmed to use the received table of contents information and songprint identifiers to identify a correlation between a digitized content master having corresponding information stored in the verification database and the digitized content copy (see discussion, col 4, line 26- col 5 line 19).

57. As per claim 57, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses the server is further programmed to verify the digitized content copy using information stored in the verification database corresponding to the correlated digitized content master (see discussion, col 4, line 26- col 5 line 19, col 7, lines15-26).

58. As per claim 58, the claim is rejected for the same reasons as claim 1, above. In addition, Carpentier discloses the server is further programmed to request at least one content portion of the digitized content copy using the identified correlation between one of the digitized content masters and the digitized content copy (see discussion, col 4, line 26- col 5 line 19, col 7, lines15-26).

***Response to Arguments***

34. Applicant's arguments with respect to claims 1-36 and 55-58 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAS

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